

REMARKS

This is in full and timely response to the final Office Action mailed June 23, 2003. Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made to correct a typographical error. Entry of this amendment is respectfully requested. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,287,716 to Hashimoto et al. Applicants respectfully traverse this rejection.

Hashimoto et al. '716 is not a proper §102(e)/103 reference because Hashimoto et al. '716 has the same assignee as this Application.

The MPEP at 2136.01 states:

For applications filed on or after November 29, 1999, a provisional rejection under 35 U.S.C. 102(e)/103 is not proper if the application contains evidence that the application and the prior art reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the invention was made.

Similarly, MPEP §2136.02 states that

For applications filed on or after November 29, 1999, if the applicant provides evidence that the application and the prior art reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the invention was made, any rejections under 35 U.S.C. 102(e)/103 based upon such a commonly owned reference should not be made or maintained.

Evidence required to establish common ownership by the applicant is discussed in MPEP §706.02(l)(2), which states that a statement can be made by an attorney of record, and that the statement concerning common ownership should be clear and conspicuous, for example, on a separate piece of paper or in a separately labeled section. Furthermore, Applicant may, but is not required to, submit further evidence, such as assignment records.

As discussed above, §1.131 or §1.132 affidavits are inappropriate to overcome this rejection.

Statement of Common Ownership

Application 09/891,501, filed June 27, 2001, and U.S. Patent No. 6,287,716 to Hashimoto et al., were, at the time the invention of Application 09/891,501 was made, owned by Mitsubishi Materials Corporation of Japan.

Accordingly, withdrawal of these rejections is respectfully requested.

Conclusion

For the foregoing reasons, claims 1 and 3-6 are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of these amendments and remarks is courteously solicited. If the examiner has any comments or suggestions that would place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number below.

Dated: September 23, 2003

Respectfully submitted,

By 

David T. Nikaido

Registration No.: 22,663

Robert S. Green

Registration No.: 41,800

RADER, FISHMAN & GRAUER PLLC

1233 20th Street, N.W.

Suite 501

Washington, DC 20036

(202) 955-3750

Attorneys for Applicant

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 180013 for any such fees; and applicant(s) hereby petition for any needed extension of time.